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JAN-27-04 11:26AM FROM-Merchant & Gould 2

p. 2

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T-526 P.004/008 F-127

O P  
MAR 09 2004

S/N Unknown

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Fodstad et al. Examiner: Unknown  
Reissue of Patent No.: 6,265,229 Group Art Unit: Unknown  
Application No.: Unknown  
Filed: Herewith Docket No.: 8966.31USRE

Title: Method For Detection of Specific Target Cells in Specialized or Mixed Cell Population and Solutions Containing Mixed Cell Populations

CERTIFICATE UNDER 37 CFR 1.10:  
"Express Mail" mailing label number: EV 372668747 US  
Date of Deposit March 9, 2004

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Mail Stop Reissue, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

Missing Parts

By: Teresa Anderson  
Name: Teresa Anderson

REISSUE DECLARATION

Mail Stop Reissue  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

We, Oystein Fodstad, Hanne Hoifodt, and Philip Rye hereby declare as follows:

1. We are citizens of Norway residing at: Frits Kiers v. 28, N-0383 Oslo; Havalstadsen 25, N-1364 Hvalstad; and Melumveien 52, N-0751 Oslo, respectively.
2. We believe that we are the original, first and joint inventors of the subject matter of the invention titled "Method and Device For Detection of Specific Target Cells in Specialized or Mixed Cell Populations and Solutions Containing Mixed Cell Populations" which invention is described and claimed in U.S. Letters Patent No. 6,265,229 which issued July

24, 2001 and described in the specification filed in the reissue application and claimed as amended by the accompanying amendment, for which invention we solicit a reissue patent.

3. We do not believe that said invention was ever known or ever used in the United States of America before our invention thereof.

4. We hereby state that we have reviewed and understand the contents of the above-identified specification including the claims as amended.

5. We hereby state that the subject matter of the claims of this reissue patent application is disclosed in U.S. Patent Application Serial No. 08/704,619, filed November 04, 1996, which is a National Phase filing of PCT/NO95/00052, filed March 10, 1995.

6. We acknowledge the duty to disclose information which is material to the examination of this reissue application in accordance with Title 37, Code of Federal Regulations, § 1.56 as well as §§ 1.97 and 1.98.

7. We believe the above-identified patent is partially inoperative by reason of claiming less than we had a right to claim in the patent. Such inoperativeness includes particularly the failure to prosecute and obtain claims commensurate with the scope of amended claims 1, 3, 43, 45, 50, 74, and 86, and new claims 89-91.

8. The amended and new claims correspond to the issued claims as follows:

- a.) Amended claim 1 corresponds to issued claim 1 with the exception that,
  - i.) "without detection of normal and malignant hematopoietic cells.", "which filter provides a matrix for cell growth;", and "growing cells of the

JAN-27-04 11:28AM FROM-Merchant &amp; Gould 2

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T-526 P.006/008 F-127

separated particle-target cell complexes on the filter; and g." have been deleted

- ii.) in step c., -- ; -- has been added.
- b.) Amended claim 3 corresponds to issued claim 3 as follows:
  - i.) "-10" has been deleted.
- c.) Amended claim 43 corresponds to issued claim 43 with the exception that,
  - i.) "without detection of normal and malignant hematopoietic cells.", "which filter provides a matrix for cell growth;", and "growing cells of the separated particle-target cell complexes on the filter; and f." have been deleted
  - ii.) in step d., -- ; -- has been added.
- d.) Amended claim 45 corresponds to issued claim 45 as follows:
  - i.) "-10" has been deleted.
- e.) Amended claim 50 corresponds to issued claim 50 as follows:
  - i.) "-10" has been deleted.
- f.) Amended claim 74 corresponds to issued claim 74 as follows:
  - i.) "23" has been deleted
  - ii.) -- 43 -- has been added.
- g.) Amended claim 86 corresponds to issued claim 86 as follows:
  - i.) "without detection of normal and malignant hematopoietic cells," has been deleted.

- h.) New claim 89 mirrors issued claim 23, rewritten in independent form with all of the limitations of the claims upon which it depended, with the exception that:
- i.) "without detection of normal and malignant hematopoietic cells,", "which filter provides a matrix for cell growth;" and "growing cells of the separated particle-target cell complexes on the filter; and g." have been deleted.
- i.) New claim 90 mirrors issued claim 22, with the exception that it is dependent on new claim 89.
- j.) New claim 91 mirrors issued claim 24, with the exception that it is dependent on new claim 89.

9. We hereby state that the error occurred without deceptive intent and that we now provide amended claims 1, 3, 43, 45, 50, 74, and 86, and new claims 89-91, in addition to the previously issued claims of U.S. Patent No. 6,265,229.

10. An Information Disclosure Statement is also provided with this reissue application. European Patent No. 0660930 resulted from an EPO National Stage filing based on PCT/N092/00151. The EPO filing was examined, allowed, and then subsequently opposed. The information disclosure statement provided herewith provides the publications cited during the opposition. While U. S. Patent Application Serial No. 08/704,619, (which lead to U. S. patent No. 6,265,229), was copending with the National Stage filing which lead to European Patent No. 0660930, during the EPO opposition, the references were not cited in the examination of U. S.

JAN-27-04 11:28AM FROM-Merchant &amp; Gould 2

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T-526 P.008/008 F-127

Patent Application No. 08/704,619. Only after issuance of U. S. Patent 6,265,229, did U. S. counsel learn of the publications cited during the opposition. The omission was uncovered when Norwegian counsel inquired into the relevance of the publications with U. S. counsel. Norwegian counsel proved to have little experience with U. S. patent laws.

11. The Information Disclosure Statement provided with this reissue application also includes a reference (Kessler et al.) cited by the Canadian Patent Office of which we became aware on May 22, 2003 in a letter from the Canadian Associate.

12. We hereby declare that all statements made herein of our own knowledge and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

1/27/04

Date



Oystein Fodstad

Date

Hanne Hoifodt

Date

Philip Rye

S/N 10/625,749

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

O I P E  
JCA  
MAR 09 2004

Applicant: Fodstad et al. Examiner: Unknown  
Reissue of Patent No.: 6,265,229 Group Art Unit: 1641  
Application No.: 10/625,749  
Filed: 07/22/2003 Docket No.: 8966.31USRE  
Title: Method For Detection of Specific Target Cells in Specialized or Mixed Cell Population and Solutions Containing Mixed Cell Populations

CERTIFICATE UNDER 37 CFR 1.10:

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Missing Parts

By: Teresa Anderson  
Name: Teresa Anderson

REISSUE DECLARATION

Mail Stop Reissue  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

We, Oystein Fodstad, Hanne Hoifodt, and Philip Rye hereby declare as follows:

1. We are citizens of Norway residing at: Frits Kiers v. 28, N-0383 Oslo;  
KALDERAVEIEN 11, 1359 EIKSMARKA  
Havalstadasen 25, N-1364 Hvalstad; and Melumveien 52, N-0751 Oslo, respectively. PDR  
23/02-2004
2. We believe that we are the original, first and joint inventors of the subject matter of the invention titled "Method and Device For Detection of Specific Target Cells in Specialized or Mixed Cell Populations and Solutions Containing Mixed Cell Populations" which invention is described and claimed in U.S. Letters Patent No. 6,265,229 which issued July

24, 2001 and described in the specification filed in the reissue application and claimed as amended by the accompanying amendment, for which invention we solicit a reissue patent.

3. We do not believe that said invention was ever known or ever used in the United States of America before our invention thereof.

4. We hereby state that we have reviewed and understand the contents of the above-identified specification including the claims as amended.

5. We hereby state that the subject matter of the claims of this reissue patent application is disclosed in U.S. Patent Application Serial No. 08/704,619, filed November 04, 1996, which is a National Phase filing of PCT/NO95/00052, filed March 10, 1995.

6. We acknowledge the duty to disclose information which is material to the examination of this reissue application in accordance with Title 37, Code of Federal Regulations, § 1.56 as well as §§ 1.97 and 1.98.

7. We believe the above-identified patent is partially inoperative by reason of claiming less than we had a right to claim in the patent. Such inoperativeness includes particularly the failure to prosecute and obtain claims commensurate with the scope of amended claims 1, 3, 43, 45, 50, 74, and 86, and new claims 89-91.

8. The amended and new claims correspond to the issued claims as follows:

a.) Amended claim 1 corresponds to issued claim 1 with the exception that,

i.) "without detection of normal and malignant hematopoietic cells,"  
"which filter provides a matrix for cell growth;," and "growing cells of the

separated particle-target cell complexes on the filter; and g." have been deleted

ii.) in step e., -- ; -- has been added.

b.) Amended claim 3 corresponds to issued claim 3 as follows:

i.) "-10" has been deleted.

c.) Amended claim 43 corresponds to issued claim 43 with the exception that,

i.) "without detection of normal and malignant hematopoietic cells," "which filter provides a matrix for cell growth;" and "growing cells of the separated particle-target cell complexes on the filter; and f." have been deleted

ii.) in step d., -- ; -- has been added.

d.) Amended claim 45 corresponds to issued claim 45 as follows:

i.) "-10" has been deleted.

e.) Amended claim 50 corresponds to issued claim 50 as follows:

i.) "-10" has been deleted.

f.) Amended claim 74 corresponds to issued claim 74 as follows:

i.) "23" has been deleted

ii.) -- 43 -- has been added.

g.) Amended claim 86 corresponds to issued claim 86 as follows:

i.) "without detection of normal and malignant hematopoietic cells," has been deleted.

- h.) New claim 89 mirrors issued claim 23, rewritten in independent form with all of the limitations of the claims upon which it depended, with the exception that:
- i.) "without detection of normal and malignant hematopoietic cells," "which filter provides a matrix for cell growth;" and "growing cells of the separated particle-target cell complexes on the filter; and g." have been deleted.
- i.) New claim 90 mirrors issued claim 22, with the exception that it is dependent on new claim 89.
- j.) New claim 91 mirrors issued claim 24, with the exception that it is dependent on new claim 89.

9. We hereby state that the error occurred without deceptive intent and that we now provide amended claims 1, 3, 43, 45, 50, 74, and 86, and new claims 89-91, in addition to the previously issued claims of U.S. Patent No. 6,265,229.

10. An Information Disclosure Statement is also provided with this reissue application. European Patent No. 0660930 resulted from an EPO National Stage filing based on PCT/N092/00151. The EPO filing was examined, allowed, and then subsequently opposed. The information disclosure statement provided herewith provides the publications cited during the opposition. While U. S. Patent Application Serial No. 08/704,619, (which lead to U. S. patent No. 6,265,229), was copending with the National Stage filing which lead to European Patent No. 0660930, during the EPO opposition, the references were not cited in the examination of U. S.

Patent Application No. 08/704,619. Only after issuance of U. S. Patent 6,265,229, did U. S. counsel learn of the publications cited during the opposition. The omission was uncovered when Norwegian counsel inquired into the relevance of the publications with U. S. counsel. Norwegian counsel proved to have little experience with U. S. patent laws.

11. The Information Disclosure Statement provided with this reissue application also includes a reference (Kessler et al.) cited by the Canadian Patent Office of which we became aware on May 22, 2003 in a letter from the Canadian Associate.

12. We hereby declare that all statements made herein of our own knowledge and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

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Date

Oystein Fodstad

02/11/2004

Hanne Hoifeldt

Date

Hanne Hoifeldt

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Date

1. 23/02 - 2004

Philip Rye

Philip Rye



S/N 10/625,749

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Fodstad et al.	Examiner:	Unknown
Reissue of Patent No.:	6,265,229	Group Art Unit:	1641
Application No.:	10/625,749		
Filed:	07/22/2003	Docket No.:	8966.31USRE
Title:	Method and Device For Detection of Specific Target Cells in Specialized or Mixed Cell Population and Solutions Containing Mixed Cell Populations		

**CERTIFICATE UNDER 37 CFR 1.10:**

"Express Mail" mailing label number: EV 372668747 US  
Date of Deposit: March 9, 2004

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Missing Parts

By: Teresa Anderson  
Name: Teresa Anderson

**WRITTEN CONSENT OF THE ASSIGNEE UNDER 37 C.F.R. § 1.172**  
**AND CERTIFICATE UNDER 37 C.F.R. § 3.73(b)**

Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

ABBOTT LABORATORIES, a corporation organized and existing under the laws of the State of Illinois, having a place of business at 100 Abbott Park Road, Abbott Park, Illinois 60064-3500, hereby consents to the filing of a reissue application for issued patent 6,265,229, filed July 22, 2003.

ABBOTT LABORATORIES certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of a chain of title from the inventors of the patent application identified above to the current assignee as shown below:

1. From: Hanne Hoifodt, and Philip Rye To: Oystein Fodstad

The document was recorded in the Patent and Trademark Office on January 27, 1997 at Reel 8324, Frame 0014.

2. From: Oystein Fodstad To: Abbott Laboratories

The document has been submitted to Patent and Trademark Office for recordation. A copy is attached herewith.

The undersigned Officer is empowered to act on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: \_\_\_\_\_

By: Jose M. de Lasa  
Name: Jose M. de Lasa  
Title: SVP and General Counsel

**CONFIRMATORY ASSIGNMENT**

WHEREAS, I, Dr. Oystein Fodstad, residing at Frits Kiers v. 28, N-0383, Oslo, Norway made certain new and useful inventions and improvements for which I filed an application for Letters Patent of the United States on November 04, 1996, application Serial No. 08/704,619 which is entitled METHOD AND DEVICE FOR DETECTION OF SPECIFIC TARGET CELLS IN SPECIALIZED OR MIXED CELL POPULATIONS AND SOLUTIONS CONTAINING MIXED CELL POPULATIONS, and upon which United States Patent Number 6,265,229 was granted, and issued on July 24, 2001.

AND WHEREAS, Abbott Laboratories, a corporation organized and existing under and by virtue of the laws of the State of Illinois, and having an office and place of business at 100 Abbott Park Road, Abbott Park, Illinois 60064-3500 (hereinafter "Assignee") is desirous of confirming the acquiring the entire right, title and interest in and to said inventions, improvements and application and in and to the Letters Patent obtained therefor;

NOW THEREFORE, to all whom it may concern, be it known that for good and valuable consideration, the receipt and sufficiency whereof is hereby acknowledged, I confirm that I have sold, assigned, and transferred, and by these presents do sell, assign and transfer unto said Assignee, its successors or assigns, the entire right, title and interest for all countries in and to all inventions and improvements disclosed in the aforesaid application, and in and to the application, all divisions, continuations, or renewals thereof, all Letters Patent which are granted and which may be granted therefrom, and all reissues or extensions of such patents, and in and to any and all applications which have been or shall be filed in any foreign countries for Letters Patent on the inventions and improvements, including an assignment of all rights under the provisions of the International Convention, and all Letters Patent of foreign countries which are and which may be granted therefrom; and I do hereby authorize and request the Commissioner of Patents and Trademarks to issue any and all United States Letters Patent for the aforesaid inventions and improvements to the Assignee as the assignee of the entire right, title and interest in and to the same, for the use of the Assignee, its successors and assigns.

AND, for the consideration aforesaid, I do hereby confirm that I have agreed and do agree that I and my executors and legal representatives will make, execute and deliver any and all other instruments in writing including any and all further application papers, affidavits, assignments and other documents, and will communicate to said Assignee, its successors and representatives all facts known to me relating to said improvements and the history thereof and will testify in all legal proceedings and

generally do all things which may be necessary or desirable more effectually to secure to and vest in said Assignee, its successors or assigns the entire right, title and interest in and to the improvements, inventions, applications, Letters Patent, rights, titles, benefits, privileges and advantages hereby sold, assigned and conveyed, or intended so to be.

AND, furthermore I confirm that I have covenanted and agreed with said Assignee, its successors and assigns, that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by me and that full right to convey the same as herein expressed is possessed by me.

IN TESTIMONY WHEREOF, I have hereunto set my hand this 11 day of  
February, 2004.

  
\_\_\_\_\_  
Dr. Oystein Fodstad

STATE OF Alabama )  
                        )  
COUNTY OF Mobile   )

On this 11<sup>th</sup> day of February, 2004, before me personally appeared Dr. Oystein Fodstad to me known and known to me to be the person described in and who executed the foregoing instrument, and he duly acknowledged to me that he executed the same for the uses and purposes therein set forth.

[SEAL]

  
\_\_\_\_\_  
Notary Public  
NOTARY PUBLIC STATE OF ALABAMA AT LARGE  
MY COMMISSION EXPIRES: Jan 23, 2007  
BONDED THRU NOTARY PUBLIC UNDERWRITERS